

**REMARKS/ARGUMENTS**

This Amendment and Response comprises Applicant's reply to a final Office Action having a mailing date of April 23, 2008. A Request for Continued Examination has also been filed herewith. At the time of examination, Claims 1-3, 5-9 and 16-45 were pending in the application, all of which have been rejected. As set forth below, Applicant has traversed all of these rejections, amended Claims 1, 22 and 32 and cancelled Claim 9. No new matter has been added. As pending Claims 1-3, 5-8 and 16-45 are believed to be in a condition for allowance, reconsideration and withdrawal of the rejection of all pending claims are respectfully requested.

**Rejection of Claims 1-3, 5-9, 16-45 under 35 U.S.C. §103(a)**

The Examiner rejected Claims 1-3, 5-9 and 16-45 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,735,851 to Errico et al. ("Errico") in view of U.S. Patent No. 6,267,765 to Taylor et al. ("Taylor"). Applicant respectfully traverses these rejections.

**Independent Claims 1, 22 and 41**

According to the Examiner, Errico teaches all of the limitations of Claims 1 and 22 with the exception of "a second end devoid of threads." He further cites Taylor as providing "evidence of the use of an implant (4) having a securing mechanism and a second end devoid of threads . . ." and concludes that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the device of Errico et al., as taught by Taylor et al. [to] immobilize the connecting element while at the same time maintain the orientation of the bone-anchoring element."

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

It is respectfully submitted that the modification of the Errico device according to the teachings of Taylor would render the Errico device inoperable and unsatisfactory for its intended purpose. Unlike in Errico, Applicant's invention is not intended to "maintain the orientation of the bone-anchoring element." Rather, the attachment device is intended to have a polyaxial relationship with (vs. maintaining the orientation of) a connector to provide greater flexibility to the surgeon. (See, e.g., Specification, p. 16, ll. 3-5.)

Further, the upper end of the shaft 100a of the screw 100 disclosed by Errico is provided in association with a cuff 130a. (See, e.g., Errico, Fig. 10a.) The cuff 130a provides a means for interconnecting the screw to the enlarged ball 124 of the stem 120. (Id.) It is respectfully submitted that without the screw threads 112 on the shaft 100a, the enlarged ball 124 would be free to move and accordingly, it would not be possible to effectively secure the enlarged ball 124 to the upper end of the shaft 100a. Moreover, it is respectfully submitted that the Examiner appears to be improperly using the Applicant's invention as a blueprint in order to modify the Errico device. Screw threads between components of the Errico device are obviously an integral part of the design envisioned by Errico. Accordingly, it is respectfully submitted that it would not be obvious for one of skill in the art to combine the teachings of Errico and Taylor.

To further clarify Applicant's invention, however, Claim 1 has been amended to note that the second end is "expandably deformable." Claims 22 and 41 already contain this limitation. Neither Taylor nor Errico teach an attachment device with a second end that is devoid of threads

and expandably deformable. Further, as noted above, it is simply not proper to combine Errico with Taylor. Accordingly, reconsideration of the rejections of independent Claims 1, 22 and 41 under 35 U.S.C. §103(a) are respectfully requested. Similarly, as Claims 2, 3, 5-7, 23-29, and 42-45 depend from allowable independent Claims 1, 22 and/or 41, reconsideration and withdrawal of the rejections of these claims is also proper.

### **Independent Claim 8**

According to the Examiner the method steps of Claims 8 and 9 “would have been obviously carried out in the operation of the device [of Errico] and, as set forth in . . . Taylor. . . .” Applicant disagrees. Nonetheless, Applicant has incorporated dependent Claim 9 (which has been cancelled) into Claim 8. Neither Taylor nor Errico disclose a connector with a head receptacle that limits the expansion of the second end of an attachment device as required by amended Claim 8. In Taylor, the hemispherical housing 12 of the bone anchoring element 1 does not expand to accept the ball end 11 of the shank 7, and the shackle 3 does not limit the expansion of the hemispherical housing 12. (See, e.g., Taylor, Col. 5, ll. 1-4; Fig. 10.) Similarly, in Errico, the rod coupling element 3 does not limit the upper portion 110a of the shaft 100a from expanding. (See, e.g., Errico, Fig. 10a.) As such, amended Claim 8 is believed to be patentable over Taylor and Errico. Thus, rejections of Claims 8 and its remaining dependent Claim 30 should be withdrawn.

### **Independent Claims 16 and 32**

Independent Claims 16 and 32 were rejected as being unpatentable over Errico in view of Taylor. Claim 32 has been amended to further clarify Applicant’s invention and is believed to be allowable over Errico and Taylor. No new matter has been added. Both Claim 16 and amended Claim 32 contain the limitation that the head receptacle of the connector limits the expansion of

the second end of the attachment device. For the reasons discussed above, Claims 16 and 32 (and all claims depending therefrom) are believed to be in condition for allowance as neither Errico nor Taylor teach this limitation. Thus, withdrawal of the rejections of these claims (and dependent Claims 17-21, 31 and 33-40) are respectfully requested.

**Amended Claims 22 and 32**

Applicant has also amended Claims 22 and 32 to address antecedent basis issues. No new matter has been added.

**CONCLUSION**

Based upon the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Dated this 25<sup>th</sup> day of August, 2008.

Respectfully submitted,

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